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EXAMINER

KIM, JENNIFER M

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,233

Applicant(s)

ERANI, SIMON

Examiner

Jennifer Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed on August 24, 2006 have been received and entered into the application.

Action Summary

The rejection of claims 1-5, 11-17, 19-23, 29-31 and 33-39 under 35 U.S.C. 103(a) as being unpatentable over Fructus et al. (US 2002/0025303A1) in view of "Brooks Industries, inc. Cosmetic Ingredients & Ideas Protein Bonded Vitamins" (Brooks II) of record is hereby expressly withdrawn in view of Fructus (WO 98/44904) of record which is an international publication applicable for 35 U.S.C 102(b) date. Accordingly, the rejection is reformulated in this Office Action and this action is made non-final.

The rejection of claims 6-10, 18, 24-28, 32 and 40 under 35 U.S.C. 103(a) as being unpatentable over Fructus et al. (US 2002/0025303A1) in view of "Brooks Industries, inc. Cosmetic Ingredients & Ideas Protein Bonded Vitamins" (Brooks II) of record as applied to claims 1, 3-5, 11-17, 19, 21-23, 29-31 and 37-39 and further in view of Saso et al. (1996) is hereby expressly withdrawn in view of Fructus (WO 98/44904) which is an international publication applicable for 35 U.S.C 102(b) date. Accordingly, the rejection is reformulated in this Office Action.

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Applicant's amendment necessitated additional rejection presented in this Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terms "a form of Vitamin A" "a form of Vitamin C", "a form of Vitamin E, "a form of Vitamin D" and "a form of Vitamin B3" set forth in claim 19 lack literal support in the specification as filed. This is a New Matter rejection.

Reminding claims are rejected to the extent that they depend from claim 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11-17, 19-23, 29-31 and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fructus et al. (WO 98/44904) in view of "Brooks Industries, inc. Cosmetic Ingredients & Ideas Protein Bonded Vitamins" (Brooks II), all of record.

Fructus et al. teach a dermatological and/or cosmetic composition for treating symptoms of skin ageing comprising a combination of at least one methylated silanol preferably, ascorbylmethylsilanol pectinate (Ascorbosilane C®, Exsymol). **(abstract, page 7, lines 10-11, page 8, lines 7-8 and 10-12)**. Fructus et al. teach **vitamin C** derivative (tocopheryl acetate), **vitamin A** derivative (retinyl palmitate) and other components can be employed in the composition **(page 12, lines 16-19, page 13, lines 1-7, Table 3, table 7)**.

Fructus et al. does not teach the employment of vitamins A (retinyl palmitate) and C (tocopheryl polypeptide) as protein bounded and cholecalciferol polypeptide and niacinamide polypeptide and the specific ratio amounts set forth in claim 2.

Brooks II teaches that the protein bonded vitamins of **vitamin A and C** (retinyl palmitate polypeptide and tocopherol polypeptide) are useful in cosmetic for the skin because they provide safe delivery system for cosmetic vitamins. **(cover page under VITAZYMES Protein Bonded Vitamins, Description of products and table on second page)**. Brooks II teaches that niacinamide polypeptide and cholecalciferol polypeptide are also available commercially and have advantages use in the skin care. **(VITAZYME D, VITAZYME B3, second page)**.

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It would have been obvious to one of ordinary skill in the art to modify the composition of Fructus et al. and employ the peptide bonded (retinyl palmitate poly peptide and tocopheryl polypeptide) in place of tocopheryl acetate and retinal palmitate. One would have been motivated to make such a modification in order to achieve safe delivery system of vitamin A and E of the composition taught by Fructus et al. Further it would have been obvious to combine commercially well-known niacinamide polypeptide and cholecalciferol polypeptide in Fructus et al's composition. One would have been motivated to make such a modification in order to achieve at least an additive effect in provided skin care composition taught by Fructus et al. and Brook II. **Applicant's newly add limitation of the terms " a form of Vitamin A" " a form of Vitamin C", "a form of Vitamin E, "a form of Vitamin D" and "a form of Vitamin B3" set forth in claim 19** is obvious because each of the active agents to be utilized are derived from the form of above vitamins and that these are inseparable characteristics.

Furthermore, no unobviousness is seen in the ratio claimed because once the usefulness of a compound is known to treat a condition, it is within the skill of the artisan to determine the optimum ratio.

Claims 6-10, 18, 24-28, 32 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fructus et al. (WO 98/44904) in view of "Brooks Industries, inc. Cosmetic Ingredients & Ideas Protein Bonded Vitamins" (Brooks II) of record as applied to claims 1, 3-5, 11-17, 19, 21-23, 29-31 and 37-39 and further in view of Saso et al. (1996), all of record.

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The teaching of Fructus et al. and Brooks II as applied as before.

Fructus et al. and Brooks do not teach the glycolic acid and the amounts.

Saso et al. teach that alpha-hydroxy acids (e.g. glycolic acid) are anti-ageing compounds. (see title, abstract).

It would have been obvious to one of ordinary skill in the art to combine glycolic acid into Fructus et al.'s composition as modified by Brooks II. One would have been motivated to combine glycolic acid into Fructus et al.'s composition as modified by Brooks II et al. in order to achieve at least an additive effect in treatment of anti-aging of skin. The motivation for combining the components flows from their individually known common utility (see *In re Kerkhoven*, 205 USPQ 1069(CCPA 1980)). It would be expected that the combination of components would treat anti-ageing of skin as well. The amounts of glycolic acid to be used is deemed obvious since they are all within the knowledge of the skilled pharmacologist and represent conventional formulations and modes of administration.

Thus, the claims fail to patentably distinguish over the state of the art as represented by the cited references.

None of the claims are allowed.

Response to Arguments

Applicant's arguments filed August 24, 2006 have been fully considered but they are not persuasive. Applicant argues claim 19 recites a method using a composition

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which includes MDT-5, a combination of a form of Vitamin A, a form of Vitamin C, a form of Vitamin e, a form of Vitamin D, and a form of Vitamin B3 excludes presence of other forms of those vitamins because the claim is drawn to the term "consisting of". This is not persuasive because the claim is drawn to limitation that is "comprising" followed by "consisting of" limitation that falls within the open limitation of "comprising" (in the same claim) is considered open language and does not exclude the presence of other forms of those vitamins. It is noted that the newly added limitation of the terms " a form of Vitamin A" " a form of Vitamin C", "a form of Vitamin E, "a form of Vitamin D" and "a form of Vitamin B3" set forth in claim 19 lack literal support in the specification as filed. Applicant argues that Applicant invented the particular combination of components and the combination is not taught or suggest by any of the art of record. This is not persuasive because the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the usefulness of each of the active agent is taught in the cited prior art to be useful in skin care composition. Therefore it would have been obvious to one of ordinary skill in the art to combine each of the active agents in a single composition in order to achieve at least an additive effect to promote better skin care. The motivation for combining the components flows from their individually known common utility (see *In re Kerkhoven*,

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205 USPQ 1069(CCPA 1980)). Thus, the claims fail to patentably distinguish over the state of the art as represented by the cited references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jennifer Kim
Patent Examiner
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Jmk
November 8, 2006